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2-7-02  
Docket No. 4406C1

10/016979  
12/12/01  
JC927 U.S. PTO

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Kowallis, Reid B.

Serial No.: ~~To be assigned~~ 10/016979

Filed: December 12, 2001 (herewith)

For: **APPARATUS AND METHOD FOR  
TRANSFERRING SMALL VOLUMES OF  
SUBSTANCES**

Group Art Unit: ~~To be assigned~~ 1743

Examiner: ~~To be assigned~~ Handy

CERTIFICATION UNDER 37 CFR 1.10
Express Mail Number: <u>EL 897 622 634 US</u>
I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" on the date indicated below and addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.
<u>December 12, 2001</u> (Date of Deposit)
<u>Cheri Gomez</u> Name of Depositing Party
<u>Cheri Gomez</u> Signature of Depositing Party

**INFORMATION DISCLOSURE STATEMENT**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

Applicants submit herewith patents, publications or other information (listed on the attached Form PTO-1449) of which they are aware, which may be material to the examination of this application and in respect of which there may be a duty to disclose in accordance with 37 CFR §1.56.

This Information Disclosure Statement:

- (a) ☒ accompanies a new patent application submitted herewith.
- (b) ☐ is filed within three months after the filing date of the application or within three months after the date of entry of the national stage of a PCT application as set forth in 37 CFR §1.491.
- (c) ☐ as far as is known to the undersigned, is filed before the mailing date of a first Office action on the merits.

- (d) ☐ as far as is known to the undersigned, is filed before the mailing date of a first Office action after the filing of a request for continued examination under § 1.114.
- (e) ☐ is filed after the first Office Action and more than three months after the application's filing date or PCT national stage date of entry filing but, as far as is known to the undersigned, prior to the mailing date of either a final action under §1.113, a notice of allowance under §1.311, whichever occurs first, and is accompanied by either the fee (\$180) set forth in 37 CFR §1.17(p) or a certification as specified in 37 CFR §1.97(e), as checked below. Should any fee be due, the U.S. Patent and Trademark Office is hereby authorized to charge Deposit Account No. 01-2213 in the amount of \$180.00 to cover the cost of this Information Disclosure Statement. Any deficiency or overpayment should be charged or credited to this deposit account. **A duplicate of this sheet is enclosed.**
- (f) ☐ is filed after the mailing date of either a final rejection or a notice of allowance, but on or before the payment of the issue fee, and is accompanied by the fee (\$180) set forth in 37 CFR §1.17(i)(1) **and** a certification as specified in 37 CFR §1.97(e), as checked below. **This document is to be considered as a petition requesting consideration of the information disclosure statement.** The U.S. Patent and Trademark Office is hereby authorized to charge Deposit Account No. 01-2213 in the amount of \$180.00 to cover the cost of this Information Disclosure Statement. Any deficiency or overpayment should be charged or credited to this deposit account. **A duplicate of this sheet is enclosed.**

[If either of boxes (e) or (f) is checked above, the following "certification" under 37 CFR §1.97(e) may need to be completed.] The undersigned certifies that:

- ☐ Each item of information contained in the information disclosure statement was first cited in a communication mailed from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this information disclosure statement.
- ☐ No item of information contained in this information disclosure statement was cited in a communication mailed from a foreign patent office in a counterpart foreign application, and, to the knowledge of the undersigned after making reasonable inquiry, was known to any individual designated in 37 CFR §1.56(c) more than three months prior to the filing of this information disclosure statement.

A copy of the items on PTO-1449 is supplied herewith:

☐ each ☒ none ☐ only those listed below:

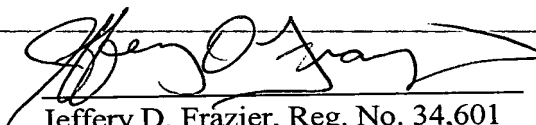
Those patent(s) or publication(s) listed in the attached PTO-1449 form are not supplied because they were previously cited by or submitted to the Office in prior application Serial Nos. 09/846,467, filed April 30, 2001, and 09/293,659, filed April 16, 1999, and relied upon in this application for an earlier filing date under 35 USC §120.

While the information and references disclosed in this Information Disclosure Statement may be "material" pursuant to 37 CFR §1.56, it is not intended to constitute an admission that any patent, publication or other information referred to therein is "prior art" for this invention unless specifically designated as such.

In accordance with 37 CFR §1.97(g), the filing of this Information Disclosure Statement shall not be construed to mean that a search has been made or that no other material information as defined in 37 CFR §1.56(a) exists. It is submitted that the Information Disclosure Statement is in compliance with 37 CFR §1.98 and MPEP §609 and the Examiner is respectfully requested to consider the listed references.

Respectfully submitted,

Date: Dec. 12, 2001

  
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U.S. DEPARTMENT OF COMMERCE, PATENT AND TRADEMARK OFFICE		Atty Docket No. 4406C1	Serial No. To be assigned
REFERENCES CITED BY APPLICANTS (Use several sheets if necessary)		Applicant Reid B. Kowallis	
		Filing Date Dec. 12, 2001	Group 1743
U.S. PATENT DOCUMENTS			

10/016979  
12/12/01

*EXAMINER INITIAL	DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
	3,164,304	01/05/65	Jager et al			
	3,329,964	07/04/67	Mutschler et al			
	3,334,354	08/01/67	Mutschler			
	3,850,775	11/26/74	Bruneau et al.			
	3,945,448	03/23/76	Sellers			
	4,351,799	09/28/82	Gross et al.			
	4,542,808	09/24/85	Lloyd, Jr. et al.			
	4,681,742	07/21/87	Johnson et al.			
	4,828,102	05/09/89	Dotson et al.			
	4,893,513	01/16/90	Schroeder et al.			
	4,952,518	08/28/90	Johnson et al.			
	5,192,506	03/09/93	Kureshy et al.			
	5,204,268	04/1993	Matsumoto			
	5,320,734	06/14/94	Yamasaki et al.			
	5,389,408	02/14/95	DeVolk			
	5,425,918	06/1995	Healey et al.			
	5,443,791	08/22/95	Cathcart et al.			
	5,508,200	04/16/96	Tiffany et al.			
	5,525,515	06/11/96	Blattner			
	5,551,487	09/03/96	Gordon et al.			
	5,587,522	12/24/96	Selby			
	5,595,707	01/21/97	Copeland et al.			
	5,601,980	02/11/97	Gordon et al.			
	5,639,665	06/1997	Arai et al.			
	5,733,509	03/31/98	Ackley et al.			
	5,746,116	05/05/98	Smith			
	5,770,860	06/23/98	Franzen			
	5,807,522	09/15/98	Brown et al.			
	5,811,306	09/1998	Komatsu			

	5,962,329	10/1999	Ershov et al.			
FOREIGN PATENT DOCUMENTS						
						TRANSLATION
	DOCUMENT	DATE	COUNTRY	CLASS	SUBCLASS	YES NO
	WO 89/10192	11/02/89	PCT			
	WO 94/00239	01/06/94	PCT			
	WO 95/35505	12/28/95	PCT			
	WO 97/44134	11/27/97	PCT			
OTHER ART (Including Author, Title, Date, Pertinent Pages, Etc.)						
	Brussolo, J.S., and Dewitt, S.H., "Automated Sample Handling Systems," <i>NetSci Articles</i> 1(5):1-10 (1995).					
	Castellino, A.M., "When the Chips are Down," <i>Genome Research</i> 7:943-946 (1997).					
	Editorial, "Getting hip to the chip," <i>Nature Genetics</i> 18(3):195-197 (1998).					
	Haystack™ brochure, <i>The Automation Partnership</i> , First Edition:October 1995.					
	Lemmo, A.V., et al., "Characterization of an Inkjet Chemical Microdispenser for Combinatorial Library Synthesis," <i>Analytical Chemistry</i> 69(4):543-551 (1997).					
Examiner		Date Considered				
<p>*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with your communication to applicant.</p>						